

Third party observations during patent prosecution in Thailand

Third party observations (TPOs) are an alternative approach to formal oppositions to patent applications that allows third parties to file relevant documents or evidence with the Patent Office while remaining anonymous. Similarly to oppositions, the aim of submitting a third party observation is to challenge the patentability of an invention. Third parties should thus provide evidence that could be considered by the patent examiner when assessing whether the invention meets the patentability criteria, e.g. evidence relating to prior art, novelty, inventiveness and industrial applicability.

TPOs overseas: a formal procedure

Both the European Patent Office (EPO) and the US Patent and Trademark Office (USPTO) have specific legal provisions pertaining to TPOs.

In the EPO, any person may file an observation after the publication of a European patent application. Once the observation has been filed, it will be communicated to the applicant who will be allowed to respond. In the meantime, TPOs will be considered by the examiner during the substantive examination of the application if they are substantiated. They might be referred to in the first office action issued after they have been filed.[1]

The USPTO refers to “TPOs” as “third party preissuance submissions” whereby third parties can submit documents that may be relevant to the examination of a new application, such as granted patents or published patent applications. Such submissions must be filed within 6 months of the first publication date of the application by the USPTO and before any office action on the merits or notice of allowance is issued.[2]

TPOs before the Thai Patent Office: an informal pre-grant opposition mechanism

Formal oppositions are regulated by Section 31 of the Thai Patent Act and can be filed within 90 days from the publication date of a patent application, by any person who considers that the invention does not meet the requirements set forth in the Thai Patent Act. During the opposition process, the burden of proof will lie on the opposing party. The applicant will have to file a counterstatement to the opposition, failing which their patent application will be deemed abandoned.

On the other hand, TPOs are not mentioned in the Thai Patent Act. However, they are allowed in practice by the Thai Patent Office. Under this current informal practice, any third party can anonymously file evidence concerning the novelty, inventiveness, and industrial applicability of a pending patent application at any time before it is granted. Since this is an informal mechanism, there is no specific form to fill in and file with the evidence, nor official fee to be paid. Likewise, the patent examiner will be under no obligation to consider the observations during the substantive examination of the application.

Therefore, the main advantages of TPOs in comparison to oppositions are that they can be filed (1) anonymously, which may circumvent conflicts with business partners, and (2) at any time during the examination process, before and after the publication of the application. However, since they do not follow any formal procedure, they may simply be dismissed at the discretion of the patent examiner

Foreseen changes to the TPOs procedure in Thailand

TPOs will be officially recognized in the upcoming new Patent Act.[3] Under the draft provisions, patent applications will undergo two rounds of publication. The first publication of the application will occur after the end of an 18-month period from the date of filing in Thailand or the first priority date, and the second publication once the substantive examination has been completed. Third party observations can be filed after the first publication of the application and before the second publication.

There is no provision regarding the acknowledgement of TPOs under the draft new Patent Act, nor any provision stating that they should be forwarded to the applicant or that the patent examiner is obliged to take them into consideration during the examination process. It could be assumed that formal guidelines will be drafted on this matter once the new Patent Act is adopted.

References:

- [1] https://www.epo.org/law-practice/legal-texts/html/guidelines/e/e_vi_3.htm (last accessed 10/01/2023).
- [2] https://www.uspto.gov/sites/default/files/documents/Quick%20Start%20Guide%20Third%20Party%20Preissuance_06-03-2015.pdf (last accessed 10/01/2023).
- [3] https://www.ipthailand.go.th/images/2563/Draft_Patent/Draft_Patent.pdf (last accessed 10/01/2023).